

**REMARKS**

Claims 1-6, 8-19 and 21-24 are currently pending in the subject application, and are presently under consideration. Claims 1-6, 8-19 and 21-24 are rejected. Favorable reconsideration of the application is requested in view of the amendments and comments herein.

**I. Rejection of Claims 1-3, 5, 9-13, 15-17, 19, 21, 23 and 24 Under 35 U.S.C. §102(e)**

Claims 1-3, 5, 9-13, 15-17, 19, 21, 23 and 24 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2002/0112156 to Gien ("Gien"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claim 1 recites receiving a commercially available token at a secure processing facility, installing an operating system on a token at the secure processing facility, writing a unique key encipherment certificate on the token at the secure processing facility, writing a Root Certificate Authority certificate onto the token at the secure processing facility, writing a unique private key onto the token at the secure processing facility, the unique private key being the matching key for the unique key encipherment certificate and loading a software package onto the token at the secure processing facility, the software package capable of cryptologically validating future keys and certificates, decrypting the keys and certificates and installing the keys and certificates in the token.

Gien does not anticipate claim 1. Anticipation requires that a single prior art reference must disclose each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Gien does not disclose receiving a commercially available token at a secure processing facility, as recited in claim 1. Gien discloses that the manufacturing *and* personalization (initial key loading or issuer specific data) of smartcard tokens must take place in a production environment (See Gien, Para. [0075]). In claim 1, a commercially available token is received at a secure processing facility. Thus, it is clear that the token recited in claim 1 need not be manufactured at the secure processing facility. Conversely, in Gien, the tokens are manufactured and initialized in the same place, namely, a secure environment (See Gien, Para.

[0007]). In the Office Action, the Examiner contends that while a token may be manufactured at the same location that personalization or installation takes place, installation still "receives" the token, even if it is receiving it out of manufacturing systems (See Office Action, Page 2).

Assuming *arguendo* that the installation receives tokens from manufacturing systems, Gien still not disclose receiving a commercially available token at a secure processing facility. Nothing in Gien discloses that any tokens employed were ever commercially available. In fact, since the tokens disclosed in Gien are manufactured and initialized in the secure environment, it can be inferred that the tokens in Gien are proprietary. Thus, Gien does not disclose receiving a commercially available token at a secure processing facility, as recited in claim 1. Accordingly, Gien does not disclose each and every element of claim 1. Thus, claim 1 is not anticipated by Gien, and claim 1 should be patentable over the cited art.

Claims 2-3, 5 and 9-13 depend from claim 1 and not anticipated for at least the same reasons as claim 1 and for the specific elements recited therein. Accordingly, claims 2-3, 5 and 9-13 should be patentable over the cited art..

Additionally, Gien does not disclose wiping the contents of a token at a secure processing facility, as recited in claim 2. Claim 2 recites a specific location that the contents of a token are wiped, namely a secure processing facility. Gien discloses that life-cycle status of a smartcard token must be irreversible, i.e., it must not be possible to erase the card and start the personalization again, unless all private key material from a personalization can be completely erased so that it cannot be recovered before, during or after the second personalization (See Gien, Para. [0071]). Gien does not disclose any particular location where the second personalization occurs. That is, Gien does not disclose wiping the contents of a token at a secure processing facility, as recited in claim 2. Accordingly, Gien does not disclose each and every element of claim 2.

Claim 15 recites a token, a token initialization machine, a secure processing facility and a Root Certificate Authority, the Root Certificate Authority signing certificates of the secure processing facility and the secure processing facility receiving the token and using the token initialization machine to install an operating system on the token, write a unique key

encipherment certificate on the token, write a unique key encipherment certificate on the token, write a certificate of the Root Certificate Authority onto the token, write a unique private key onto the token, and load a software package onto the token where the software package is capable of cryptologically validating future keys and certificates, decrypting the keys and certificates, and installing the keys and certificates in the token.

Gien does not disclose a secure processing facility receiving a token, and using a token initialization machine, as recited in claim 15. In claim 15, since the secure processing facility receives the token, it is clear that the token need not be manufactured at the secure processing facility. Conversely, as stated above with respect to claim 1, Gien discloses that a smartcard is manufactured and initialized in a production environment. Thus, Gien does not disclose that a secure processing facility receives a token, as recited in claim 15. In the Office Action, the Examiner states that it is clear that the secure environment disclosed in Gien receives tokens, otherwise, how could installation of keys and personalization take place? (See Office Action, Page 3). It is respectfully submitted that in Gien, the installation of keys and personalization could take place during the manufacturing process, e.g., if the keys and the personalization of tokens are hardwired onto the token. Accordingly, Gien does not disclose each and every element of claim 15. Thus, claim 15 is not anticipated by the cited art, and claim 15 should be patentable over the cited art.

Claims 16-17, 19 and 21 depend either directly or indirectly from claim 15 and are not anticipated by the cited art for the same reasons as claim 15, and for the specific elements recited therein. Accordingly, claims 16-17, 19 and 21 should be patentable over the cited art.

Additionally, claim 21 recites that a token comprises a commercially available token. Gien discloses that a smartcard and a private key are intended for use within the context of a four-corner trust model (See Gien, Para. [0008]). However, nothing in Gien discloses that the tokens are commercially available tokens. In fact, since the tokens are manufactured and initialized in the same place (the secure environment), there would be no reason to employ commercially available tokens in Gien. Thus, Gien does not disclose each and every element of claim 21.

Claim 23 recites receiving a commercially available token, installing an operating system on the token, writing a unique key encipherment certificate onto the token, writing a Root Certificate Authority certificate onto the token, writing a unique private key onto the token and loading a software package onto the token. For the reasons stated above with respect to claim 1, Gien does not disclose receiving a commercially available token, as recited in claim 23. Thus, Gien does not disclose each and every element of claim 23. Thus, claim 23 is not anticipated by the cited art, and claim 23 should be patentable over the cited art.

Claim 24 depends from claim 23 and is not anticipated by the cited art for the same reasons as claim 23 and for the specific elements recited therein. Accordingly, claim 24 should be patentable over the cited art.

For the reasons described above, claims 1-3, 5, 9-13, 15-17, 19, 21, 23 and 24 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

## **II. Rejection of Claim 4 Under 35 U.S.C. §103(a)**

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Gien in view of U.S. Patent No. 5,721,781 to Deo ("Deo"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

The addition of Deo does not make up for the aforementioned deficiencies of Gien, with respect to claim 1, from which claim 4 depends. Accordingly, Gien and Deo, taken individually or in combination do not teach or suggest each and every element of claim 4. Thus, claim 4 is not rendered obvious by the cited art.

For the reasons described above, claim 4 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

## **III. Rejection of Claims 6 and 18 Under 35 U.S.C. §103(a)**

Claims 6 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gien in view of U.S. Patent No. 6,290,137 to Kiekhäfer ("Kiekhäfer"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

The addition of Kiekhaefer does not make up for the aforementioned deficiencies of Gien, with respect to claim 1, from which claim 6 depends. Accordingly, Gien and Kiekhaefer taken individually or in combination, do not teach or suggest each and every element of claim 6. Thus, claim 6 is not rendered obvious by the cited art.

The addition of Kiekhaefer does not make up for the aforementioned deficiencies of Gien, with respect to claim 15, from which claim 18 depends. Accordingly, Gien and Kiekhaefer taken individually or in combination, do not teach or suggest each and every element of claim 18. Thus, claim 18 is not rendered obvious by the cited art.

For the reasons described above, claims 6 and 18 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

**IV. Rejection of Claim 8 Under 35 U.S.C. §103(a)**

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Gien in view of EP Patent No. 117206A2 to Corella ("Corella"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

The addition of Corella does not make up for the aforementioned deficiencies of Gien, with respect to claim 1, from which claim 8 depends. Accordingly, taken individually or in combination, Corella and Gien do not teach or suggest each and every element of claim 8. Thus, claim 8 is not rendered obvious by the cited art.

For the reasons described above, claim 8 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claims 14 and 22 Under 35 U.S.C. §103(a)**

Claims 14 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gien in view of Corella in view of U.S. Patent NO. 6,738,901 to Boyles ("Boyles"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

The addition of Corella and Boyles do not make up for the aforementioned deficiencies of Gien, with respect to claim 1, from which claim 14 depends. Accordingly, taken individually

or in combination Gien, Corella and Boyles fail to teach or suggest each and every element of claim 14. Thus, claim 14 is not rendered obvious by the cited art.

The addition of Corella and Boyles do not make up for the aforementioned deficiencies of Gien, with respect to claim 15, from which claim 22 depends. Accordingly, taken individually or in combination Gien, Corella and Boyles fail to teach or suggest each and every element of claim 22. Thus, claim 22 is not rendered obvious by the cited art.

For the reasons described above, claims 14 and 22 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

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**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

Date 5/31/06

  
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